

### **REMARKS**

The application has been reviewed in light of the Office Action mailed on June 25, 2008. The specification and claims 1, 3, 4, 13 and 14 have been amended without adding new matter. Reconsideration of the application is respectfully requested for the following reasons.

The following portion of paragraph [0206] of the specification is objected to: "It [the program] may be recorded on other recording mediums (CD-ROM, a magneto-optic disk, a memory card, a flexible disk, etc.)." The Office Action suggests (at p. 2) that the term "etc." should be deleted because "the computer readable medium can not be electronic signal or waveform." Please note, however, that the term "etc." relates to "other recording mediums," and states that the list of exemplary recording mediums is not exhaustive. Applicant has amended the paragraph by adding the term "for example" before the first example of a recording medium. Applicant submits that no further amendment is required.

Claims 1-8, 10 and 12-16 stand rejected under 35 U.S.C. 103 as being unpatentable over Watanabe et al., U.S. Patent Publication 2002/0105873 ("Watanabe") in view of Kato et al., U.S. Patent 7,106,680 ("Kato"). Reconsideration is respectfully requested for the following reasons.

Initially, this rejection is traversed because Kato is not a proper reference under 35 U.S.C. 103. Sub-section (c) of 35 U.S.C. 103 provides that

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This is the case here. First, Kato was developed by another person. Second, Kato qualifies as prior art only under subsection (e) of 35 U.S.C. 102. Kato was filed on April 29, 2003 and published (as U.S. publication 2003/0227850) on December 11, 2003. The subject application is the U.S. national stage of PCT/JP04/1333, which was filed on September 13, 2004. The

application also claims priority from a foreign application filed on September 16, 2003. An accurate translation of the priority document is attached. Third, Kato and the subject application were, at the time the claimed invention was made, subject to an obligation of assignment to Ricoh Company, Ltd. For at least this reason, the rejection should be withdrawn.

Moreover, the cited references do not render obvious the claimed invention. Claim 1 recites a recording condition setting method comprising “acquiring a plurality of setting values of the record timing conditions for a number of group data conforming to a linear velocity of the optical disk at a record position on the recording surface where the information is recorded.” This is an important feature of the claimed invention which relates to, *inter alia*, a high-speed recording method with stable recording quality.

As disclosed in the specification, “information related to the parameter which determines the pulse form ... is included in the record strategy information for every linear velocity.” Different setting values are “stored as the amount of change (the amount of delay or the amount of advance) of the rise timing and the fall timing to the basic pulse form.” Paragraphs [0111], [0115]; see also Fig. 8. The claimed invention is not limited to the disclosed embodiments.

The Office Action asserts (at p. 2) that Watanabe meets the foregoing limitation, and relies on Fig. 1 and paragraph 44. Applicant respectfully disagrees. The cited portion of Watanabe discloses that “the linear velocity changes depending on the laser pulse irradiation position on the optical disc 1. Therefore, a system clock used in various processes performed to record data is altered in accordance with the irradiation position of the laser pulse on the optical disc 1.”

The foregoing portion of Watanabe teaches that “a system clock ... is altered in accordance with the irradiation position.” Watanabe, however, fails to teach or suggest “acquiring a plurality of setting values of the record timing conditions for a number of group data conforming to a linear velocity of the optical disk at a record position,” as recited in claim 1. Kato fails to remedy the deficiency of Watanabe. For this additional reason, the rejection should be withdrawn.

Moreover, Applicant disagrees that the references are properly combinable as asserted on page 3 of the Office Action.

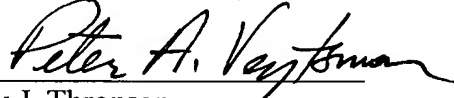
Claim 1 is allowable for at least the foregoing reasons. Claims 2-8 and 10 depend from claim 1 and are allowable for the same reasons, and also because the unique combinations recited in the dependent claims are patentable. Claims 12-16 are allowable for the reasons claim 1 is allowable, and for other reasons.

Claim 9 stands rejected under 35 U.S.C. 103 as being unpatentable over Watanabe and Kato, further in view of Iida, U.S. Patent 6,377,525 ("Iida"). Claim 11 stands rejected under 35 U.S.C. 103 as being unpatentable over Watanabe and Kato, further in view of Adachi et al., U.S. Patent 7,027,370 ("Adachi"). These rejections are based upon the improper combination of Watanabe and Kato, as discussed above, and should be withdrawn. In addition, claims 9 and 11 depend from claim 1 and are allowable because claim 1 is allowable, and for other reasons.

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

Dated: September 25, 2008

Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082

Peter A. Veytsman

Registration No.: 45,920

DICKSTEIN SHAPIRO LLP

1825 Eye Street, NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicant